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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,095	11/14/2003	Kazushige Sugimoto	3673-0161P	8209

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EXAMINER	
LEE, EDMUND H	

ART UNIT	PAPER NUMBER
1791	

NOTIFICATION DATE	DELIVERY MODE
04/11/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/712,095	SUGIMOTO	
	Examiner	Art Unit	
	EDMUND H. LEE	1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 January 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8 and 10-12* is/are pending in the application.

4a) Of the above claim(s) *1-6* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *7-8 and 10-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 7-9 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 59-81059 in view of Richard (USPN 3640028) and Glaser (USPN 3268634). In regard to claim 7, JP 59-81059 teaches all of the basic claimed process limitations except using a roller including a portion having a small diameter, which is concaved along a surface of the golf ball; and using a roller having a plurality of grooves on a surface of the portion having the small diameter. JP 59-81059 does not teach the using a roller having the claimed shape including axial grooves. Richard teaches a method of removing molding flashing from a surface of a golf ball by rotating a ball on a roller including a portion having a small diameter, which is concaved along a surface of the golf ball (fig 3). JP 59-81059 and Richard are combinable because they are analogous with respect to rolling a golf ball on a roller. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the roller of Richard in the process of JP 59-81059 in order to better position and gyrate the golf ball of JP 59-81059. Glaser teaches using a roller having a plurality of grooves on a surface of the portion having the small diameter (col 2, lns 24-33; fig 4). JP 59-81059 (modified) and Glaser are combinable because they are analogous with respect to rolling a golf ball on rollers. Thus, it would have been obvious to one of ordinary skill in the art at the time

the invention was made to using rollers having grooves thereon as taught by Glaser in the process of JP 59-81059 (modified) in order to improve gripping of the ball by the rollers. It should be noted that Glaser teaches grooves on the rollers (fig 3). Though the grooves are not axial, the specific groove pattern is a mere obvious matter of choice dependent on equipment availability and of little patentable consequence to the claimed process since it is not a *manipulative* feature or step of the claimed process. Further, rollers/guides having axial grooves are notoriously well-known in the molding art and orienting art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to redesign the grooves of JP 59-81059 (modified) to have axial grooves in order to enhance rotation of the balls by increasing friction. In regard to claims 8 and 10, the specific roller design is a mere obvious matter of choice dependent on the desired final product and equipment availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, the claimed design is well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the claimed design in the process of JP 59-81059 (modified) in order to improve positioning. In regard to claim 11, the specific speed is well-known in the molding art as an important molding parameter and the desired speed would have been obviously and readily determined through routine experimentation by one having ordinary skill in the art at the time the invention was made. Further, the claimed speed is generally well-known in the molding art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to rotate the roller of JP 59-

81059 at the claimed speed in order to reduce cycle time without compromising quality. In regard to claim 12, such are taught by the above combination of JP 59-81059 and Richard.

3. Applicant's arguments filed 1/15/08 have been fully considered but they are not persuasive. Applicant argues that JP 59-81059 and Richard are not combinable because JP 59-81059 is drawn towards orienting a golf ball whereas Richard is drawn towards grinding a golf ball. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the wheel/roller of Richard is used to rotate the golf ball in order to grind off burrs. The fact that the concave portion of the wheel/roller reorients the ball against a grinding surface is a benefit that one of ordinary skill in the art would recognize. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a roller having a concave portion in order to facilitate reorientation of a rotating golf ball.

Applicant also argues that the claimed axial grooves contribute to the performance of the claimed method.This argument is misplaced because the instant claims recite neither the claimed benefits of using axial grooves nor a positive use of the axial

grooves. As the claims are written now, the axial grooves do not contribute a manipulative feature to the claimed process.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following US patents teach the use of rollers having axial grooves: 1054721 and 6833098.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is

571.272.1204. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571.272.1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EDMUND H. LEE
Primary Examiner
Art Unit 1732

EHL
/EDMUND H. LEE/

Primary Examiner, Art Unit 1791